



PATENT

AF
JFW

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANTS: Klaus R. MOELLER et. al. CONF. NO.: 1150
SERIAL NO.: 10/646,734 GROUP: 2614
FILED: August 25, 2003 EXAMINER: Lao, Lun-See
FOR: NETWORKED SOUND MASKING AND PAGING SYSTEM

APPELLANT'S BRIEF ON APPEAL UNDER 37 C.F.R. §41.37

Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

October 13, 2010

Mail Stop Appeal Briefs - Patents

APPELLANTS' REPLY BRIEF UNDER 37 C.F.R. § 41.41

Madam:

In response to the Examiner's Answer mailed August 17, 2010, Applicants request the appeal be maintained and supply the following arguments in reply under 37 C.F.R. § 41.41(a)(1).

I. STATUS OF CLAIMS:

Claims 108-119 are pending; with claims 108, 114 and 116 being written in independent form.¹

¹ See page 1 of the August 24, 2009 Final Office Action.

A. Claims 108-118 stand finally rejected under U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,319,088 ("Orfield") in view of U.S. Patent Application Publication No. 2002/0072816 ("Shdema").²

B. Claim 119 stands finally rejected under U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,319,088 ("Orfield") as modified by U.S. Patent Application Publication No. 2002/0072816 ("Shdema") as applied to claim 116, and in further view of U.S. Patent No. 4,686,693 ("Ritter").³

II. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL:

The Appellant seeks the Board's review of the following rejections:

A. Claims 108-118 stand finally rejected under U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,319,088 ("Orfield") in view of U.S. Patent Application Publication No. 2002/0072816 ("Shdema").⁴

B. Claim 119 stands finally rejected under U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,319,088 ("Orfield") as modified by U.S. Patent Application Publication No. 2002/0072816 ("Shdema") as applied to claim 116, and in further view of U.S. Patent No. 4,686,693 ("Ritter").⁵

Claims 108-119 are being appealed.

² See page 2 of the August 24, 2009 Final Action.

³ See page 10 of the August 24, 2009 Final Action.

⁴ See page 2 of the August 24, 2009 Final Office Action.

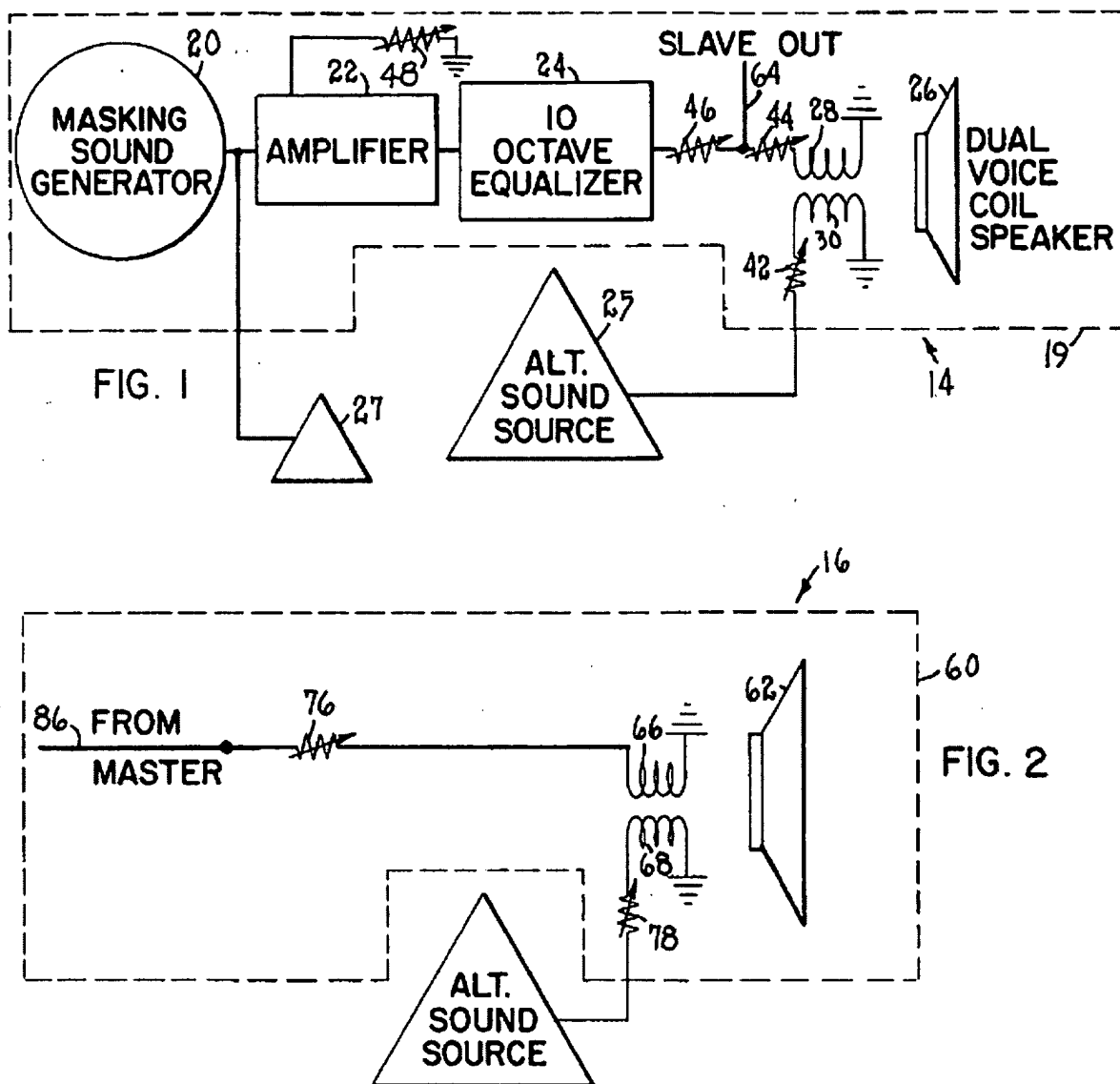
⁵ See page 10 of the August 24, 2009 Final Office Action.

III. ARGUMENT

In the Examiner's Answer, the Examiner clarifies his reading of the claim terms "sound masking units" and "control unit" such as recited in, for example, claim 108.⁶ In particular, the Examiner makes clear he is reading the sound masking units on the slave units 16 shown in Fig. 2 of Orfield, and is reading the control unit on the master unit 14 shown in Fig. 1 of Orfield. In particular, the Examiner also reads the "sound masking signal generator" in the sound masking unit of claim 108 on the speaker 62 in the slave unit 16 shown in Fig. 2 of Orfield. This differs from the reasoning provided in the Final Office Action dated August 24, 2009 from which this appeal was filed.⁷ Figs. 1 and 2 of Orfield have been reproduced below for convenience.

⁶ See pages 4-5 and 15-16 of the Examiner's Answer.

⁷ See pages 2-3 of the August 24, 2009 Final Office Action.



As shown in Fig. 1 of Orfield, the master unit 14 (not the slave unit 16) includes a masking sound generator 20 generating a masking sound signal, which passes through an amplifier 22 and an equalizer 24. Manually controlled potentiometers 48 and 46 control output of the amplifier 22 and the equalizer 24, respectively.⁸

⁸ See column 3, line 15-column 4, line 2 of Orfield.

The Examiner alleges that since the master unit 14 of Orfield generates a sound masking signal, controls the volume of the sound masking signal and controls the frequency of the volume controlled sound masking signal, the resulting output signal of the master unit 14 provides the claimed “masking volume signal” and “sound masking frequency signal.”

This reasoning is flawed. The master unit 14 sends a single signal to the slave unit 16, and this single signal drives a speaker 62 in the slave unit 16. The master unit 14 does not send separate masking volume and sound masking frequency signals as required of the control unit of claim 108.

Furthermore, since the slave unit 16 does not receive a masking volume signal and a sound masking frequency signal, it is incorrect for the Examiner to assert that (i) the slave unit 16 generates a sound masking output signal and (ii) that the slave unit 16 generates a sound masking signal in response to the masking volume signal and the sound masking frequency signal as required of the sound masking unit in claim 108.

That a single signal is sent by the master unit 14 in Orfield to drive the speaker 62 in the slave unit 16 also highlights that the slave unit 16 is NOT connected to the master unit 14 by a communication network as required by claim 108. Still further, one skilled in the art would not confuse a speaker cable 18, which connects the master unit 14 and the slave unit 16, with a communication network and associated interfaces as recited in claim 108.

The Examiner further contends that one skilled in the art would have found it obvious to add a processor as taught in Shdema to the slave units 16 of Orfield.⁹ Appellants do not understand this logic; namely, there is no rational underpinning for this contention. See KSR Int'l Co. v. Teleflex, Inc.,

⁹ See Pages 5-6 and 16 of the Examiner's Answer.

127 S.Ct. 1727, 1741, 82 USPQ2d 1385, 1396 (2007) (when accounting for differences between the claims and the applied art, the Examiner must provide “some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness”). The slave units 16 in Orfield are basically speakers, and all processing of a signal to drive a speaker is performed at the master unit 14; hence the terminology, master and slave used with respect to these units. Placing a processor in the slave unit 16 would serve no purpose in achieving Orfield’s intended purpose, and would also ruin or disrupt the master/slave configuration intended by Orfield. As such this is a clear teaching away from making such a modification, and the combination would not have been obvious to one skilled in the art. KSR, 127 S.Ct. at 1739 (“when the prior art teaches away from combining certain known elements, discovery of a successful means of combining them is more likely to be nonobvious”).

Finally, the Examiner cites case law on page 18 of the Examiner’s Answer to rebut Appellant’s other arguments that it would not have been obvious to combine Orfield and Shdema. The Examiner’s citations amount to nothing more than boilerplate, conclusory statements that fail to address the lack of motivation arguments set forth on pages 35-38 of the Appeal Brief. The Examiner bears the initial burden of presenting a prima facie case of obviousness in rejecting claims under 35 U.S.C. § 103. *See In re Rijckaert*, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. *See In re Fine*, 837 F.2d 1071, 1073, 5 USPQ2d 1956, 1958 (Fed. Cir. 1988). In so doing, the Examiner must make the factual determinations set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), viz., (1) the scope and content of the prior art; (2) the differences between the prior art and the claims at issue; and (3) the level of ordinary skill in the art. “[T]he examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a

prima facie case of unpatentability.” *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). Furthermore, “there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness’...[H]owever, the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the would employ.” *KSR Int’l Co. v. Telefax Inc.*, 127 S.Ct. 1727, 1741, 82 USPQ2d 1385, 1396 (2007) (quoting *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006)). Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See *Oetiker*, 977 F. 2d at 1445, 24 USPQ2d at 1444.

The Examiner contends on page 18 of the Examiner’s Answer:

In response to Applicant’s argument that there is no suggestion to combine the references, the Examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Shdema et al. teaches the deficiencies of Orfield with respect to the claimed invention.

However, Appellants provided detailed and supported reasoning on page 35-38 as to only one skilled in the art would not have combined Shdema with Orfield. The Examiner does not address any of these arguments and, in view of these arguments or provided a rationale underpinning for the asserted combination. In view of these arguments, the Examiner has not established that one skilled in the art would have combined Shdema with Orfield.

For the reasons set for the above, claim 108 is not rendered obvious to one skilled in the art by Orfield in view of Shdema. Claims 114 and 116 include similarly argued limitations, and are likewise not rendered obvious by Orfield in view of Shdema. Since the remaining claims depend either directly or

indirectly from the associated independent claims, it is submitted that the dependent claims are also not obvious for similar reasons. Accordingly, the Appellant respectfully requests that the Examiner's rejection of claim 108-118 under U.S.C. § 103(a) as allegedly being obvious over Orfield in view of Shdema be reversed.

IV. CONCLUSION

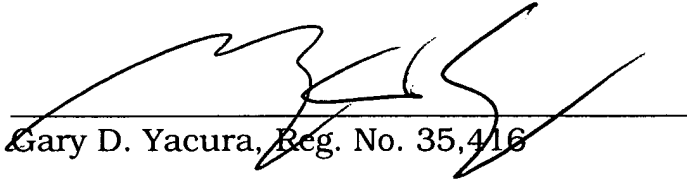
Appellants respectfully maintain their request that the Board reverse the Examiner's rejections of the pending claims.

The Commissioner is authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 08-0750 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

Respectfully submitted,

HARNESS, DICKY, & PIERCE, P.L.C.

By



Gary D. Yacura, Reg. No. 35,416

P.O. Box 8910
Reston, Virginia 20195
(703) 668-8000

GDY